



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,494	08/20/2001	Stephen Paul Morgan	ARC920010079US1	5917

7590 12/29/2003

John L. Rogitz
Rogitz & Associates
Suite 3120
750 B Street
San Diego, CA 92101

EXAMINER

MARTINEZ, DAVID E

ART UNIT	PAPER NUMBER
----------	--------------

2182

DATE MAILED: 12/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,494

Applicant(s)

MORGAN, STEPHEN PAUL

Examiner

David E Martinez

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-6, 8, 10, 12-15, 17, 19-21, 23-24, and 26, are rejected under 35

U.S.C. 102(e) as being anticipated by US Patent No. 6,477,624 to Kedem et al.

As per claim 1, Kedem teaches a system, comprising:

a computer [figs 2, 3, element 100] including a central processing unit (CPU) [fig 3, element 302] but not including a local hard disk drive [col 2, line 65 to col 3 line 6, column 3, lines 28-47, and line 62 to column 4 line 3, and lines 24-64];

an adapter [figs 3, 4, element 202] coupled to the CPU [fig 3, element 302] for receiving local disk I/O requests therefrom, the adapter translating disk I/O requests into network I/O requests [col 2, line 65 to col 3 line 6, column 3, lines 28-47, and line 62 to column 4 line 3, and lines 24-64, although not explicitly taught, it is inherent the adapter performs translation in order to be able to handle requests from a cpu and to communicate to a remote server through a network]; and

at least one network resource communicating with the adapter for satisfying the local disk I/O requests [col 2, line 65 to col 3 line 6, column 3, lines 28-47, and line 62 to column 4 line 3, and lines 24-64].

Art Unit: 2182

As per claim 10, Kedem teaches a method for facilitating, in a diskless computer, the use of an operating system not modified to not issue local disk I/O requests [col 2, line 65 to col 3 line 6, column 3, lines 28-47, and line 62 to column 4 line 3, and lines 24-64, column 10, lines 56-62] comprising:

receiving local disk I/O requests from the operating system [col 2, line 65 to col 3 line 6, column 3, lines 28-47, and line 62 to column 4 line 3, and lines 24-64]; and

satisfying the local disk I/O requests by accessing a network communicating with the diskless computer, wherein the satisfying act includes translating the local disk I/O requests to network requests at an adapter engaged with the diskless computer, transparently to a CPU in the diskless computer [col 2, line 65 to col 3 line 6, column 3, lines 28-47, and line 62 to column 4 line 3, and lines 24-64, column 10, lines 56-62].

As per claim 19, Kedem teaches a diskless computer, comprising:

a CPU [fig 3, element 302] running an operating system not modified to not issue local disk I/O requests [col 2, line 65 to col 3 line 6, column 3, lines 28-47, and line 62 to column 4 line 3, and lines 24-64];

a disk-free adapter [figs 3, 4, element 202] communicating with the operating system and receiving disk I/O requests therefrom, the adapter translating the disk I/O requests to network requests [col 2, line 65 to col 3 line 6, column 3, lines 28-47, and line 62 to column 4 line 3, and lines 24-64]; and

a network connection through which the disk I/O requests can be satisfied despite the lack of a local hard disk drive in the computer [col 2, line 65 to col 3 line 6, column 3, lines 28-47, and line 62 to column 4 line 3, and lines 24-64, column 14, lines 11-22].

As per claims 2, 12 and 20 Kedem teaches the adapter is plugged into a motherboard holding the CPU [column 6, lines 34-39, pc cards are pluggable into a motherboard].

Art Unit: 2182

As per claims 3, 13 and 21, wherein the adapter is connected by a connecting cable to a motherboard holding the CPU [fig 3, element 302(a), column 10, lines 38-46]

As per claims 5, 14, and 23, Kedem teaches the adapter is also a computer network adapter [see claim 1].

With regards to claims 6, 15, and 24, Kedem teaches the system of Claim 1, wherein the adapter is not a conventional computer network adapter, the computer including a conventional network adapter separate from the adapter [fig 4, column 11, lines 55-61, column 14, lines 11-22].

As per claims 8, 17, and 26, Kedem teaches the adapter causes a conventional operating system configured for generating local disk I/O requests to be loaded from a network storage to a volatile memory in the computer [although not explicitly taught, it is inherent the system must have some kind of volatile memory if there is no hard drive for the O/S to run on, col 2, line 65 to col 3, line 6].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 18, and 27, are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,477,624 to Kedem et al.

As per claims 9, 18, and 27, although not explicitly taught by Kedem, it is well known in the art, adapter cards are housed within a computer that uses it for their protection of outside elements.

Art Unit: 2182

It would have been obvious to one of ordinary skill in the art at the time of the invention to house the adapter card within the computer to protect it from other elements interfering with its function.

Claims 7, 16 and 25, are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,477,624 to Kedem et al. as applied to claims 1, 10, and 19, above, and further in view of US Patent No. 5,802,365 to Kathail et al.

As per claims 7, 16 and 25, Kedem fails to teach an adapter to include a sequence of bytes identifying the adapter to the CPU as a secondary boot device. However, Kathail teaches a PCI boot device (an adapter) providing a set of properties such as its identification, to the system in which it is installed within (controlled by a CPU) during boot up for the purpose of recognizing the device so it can be configured and used by the system [column 39, lines 35-55].

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of both Kedem and Kathail to have the adapter include a sequence of bytes identifying the adapter to the CPU as a secondary boot device for the purpose of recognizing the device so it can be configured and used by the system to be able to access data from a remote location.

Response to Arguments

Applicant's arguments with respect to claims 1-3, 5-9, 10, 12-17, 19-21, and 23-27, have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2182

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E Martinez whose telephone number is (703) 305-4890. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be reached on (703) 308-3301. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

DEM


JEFFREY GAFFIN
SUPERVISOR/PATENT EXAMINER
TECHNOLOGY CENTER 2100